

REMARKS

I. Introduction

Claims **1, 6-23, 25-29, 34-36, 38-39, 41, 56-57, 61, 63, 69-80, 97, and 99-114** are currently pending in the present application. Claims **1, 29, 38-39, 41, 56-57, 61, 63, 69-80, and 99-114** are independent.

All pending claims stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,112,186 (hereinafter "Bergh") in view of U.S. Patent No. 5,227,874 (hereinafter "Von Kohorn"), in further view of U.S. Patent No. 6,876,983 (hereinafter "Goddard"), in further view of U.S. Patent No. 6,598,026 (hereinafter "Ojha").

Further, while the Examiner indicates that Applicants' priority claim to U.S. Patent No. 6,754,636 is valid, the Examiner further indicates that Applicants' claim of priority to U.S. Patent No. 6,249,772 is not "granted", in as much as the pending claims are alleged to not be supported under 35 U.S.C. §112, first paragraph by the priority document. The Examiner does not address Applicants' priority claims to any of U.S. Patent Application Nos. 09/190,744 (filed November 28, 1998), 09/083,345 (filed May 22, 1998), 08/889,319 (filed July 8, 1997), or 08/707,660 (filed on September 4, 1996).

Upon entry of this amendment, which is respectfully requested, new claims **115-118** will be added. No new matter is believed to be introduced by this amendment, and the Examiner has already conducted presumably numerous searches directed to the concepts recited by the currently pending claims.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.114.

II. Priority

Applicants respectfully note that the "brand indifference" concepts of the pending claims find plentiful support and description throughout at least the specification of U.S. Patent Application Serial No. 09/190,744 (a parent of U.S. Patent No. 6,754,636), filed on November 28, 1998. While such support is replete throughout the above-mentioned

priority document, Applicants direct the Examiner's attention, for exemplary purposes, to pg. 68, line 11 to pg. 69, line 6, thereof.

Applicants note that the filing date of U.S. Patent Application Serial No. 09/190,744 (November 28, 1998) pre-dates the earliest effective filing date of both Goddard (December 2, 1998) and Ojha (January 25, 1999). To the extent the pending claims are supported by the written description and specification of U.S. Patent Application Serial No. 09/190,744, such claims are therefore entitled to a priority date of November 2, 1998, which pre-dates both Goddard and Ojha.

Accordingly, neither Goddard nor Ojha are valid prior art references.

III. The Examiner's Rejections - 35 U.S.C. §103(a) – Bergh, Von Kohorn, Goddard, Ojha

All pending claims stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bergh in view of Von Kohorn, in further view of Goddard, in further view of Ojha. Applicants traverse this ground for rejection as follows.

A. Rejections Based on Non-Prior Art References

As described in Section II herein, neither Goddard nor Ojha are valid prior art references. Accordingly, Applicants respectfully request that this §103(a) ground of rejection of the pending claims be withdrawn.

B. No *Prima Facie* Case of Obviousness

Further, it is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

The conclusory and unsupported statements made by the Examiner in an attempt to show how or why one of ordinary skill in the art would have been motivated to make the combination suggested by the Examiner fall far short of the requisite substantial evidence required to set forth a *prima facie* case of obviousness. The Examiner does not, for example, provide any support for why one would have combined Bergh and Von Kohorn, Bergh and Goddard, Bergh and Ojha, Von Kohorn and Goddard, Von Kohorn and Ojah, or Goddard and Ojha. Unless and until the Examiner meets the *prima facie* burden of providing evidence of such alleged motivations, Applicants are under no burden to provide evidence to the contrary, as the Examiner has simply failed to set forth a *prima facie* case that any pending claims are rendered obvious by any prior art reference or any combination of prior art references that one of ordinary skill in the art would have been motivated to make.

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this § 103(a) ground for rejection be withdrawn.

IV. New Claims

New claims **115-118** are believed to be patentable over the cited reference at least for the reasons otherwise presented herein. Further, after reviewing the cited references, Applicants believe that the cited references fails to teach, suggest, or render obvious at least:

- (i) *receiving, from a customer, an indication of a type of product that the customer is willing to purchase from any one of a first retailer and a second retailer (claim 115);*
- (ii) *receiving an indication of a subset of the list of available products, the indication defining the subset as a customer-defined product category (claims 116-118);*
- (iii) *wherein the receipt of the indication of the subset of the list of available products comprises a binding offer, by the customer, to purchase any one of the products from the customer-defined product category that the controller chooses, in the case that the customer provides an indication that a purchase within the category is desired (claim 117); or*
- (iv) *wherein the indication of the subset of the list of available products defining the customer-defined product category includes an indication of a customer-defined name for the customer-defined product category (claim 118).*

V. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at cfincham@walkerdigital.com, at the Examiner's convenience.

VI. Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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